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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-----------------------------------|--------------------|
| 09/665,912 | 09/20/2000 | Morihiro Murata | 51270-024 5656 | 5458 |
| 7590 | 11/01/2004 | | | |
| Roger R. Wise Pillsbury, Madison & Sutro LLP 725 South Figueroa Street Suite 1200 Los Angeles, CA 90017-5443 | | | EXAMINER PSITOS, ARISTOTELIS M | |
| | | | ART UNIT 2653 | PAPER NUMBER 19 |

DATE MAILED: 11/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|----------------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/665,912 | MURATA, MORIHIRO |
| | Examiner Aristotelis M Psitos | Art Unit 2653 |

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 09 September 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,2,4,5,8,12,14-27,29,31-33,38,39 and 44 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 8,12,14-27,29,31,33,38 and 39 is/are allowed.
- 6) Claim(s) 1,2,5,32 and 44 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/9/04 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1 and 32 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sawada et al.

With respect to claims 1 and 32, Sawada et al discloses in an optical recording/reproducing system the ability of erasing the appropriate pma (file control data) and subsequently rewriting such back to the pma as desired – see the discussion with respect to figures 3-5 and starting at col. 5 line 62 to col. 6 line 11.

The examiner interprets the control data as inherently comprising of the claimed frame information (disc type) and track no.

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If applicant can convince the examiner that such is not inherently present in the document, then the examiner would rely upon either of the acknowledged prior art or the previously recited Lee patent for teaching such. *et al*

It would have been obvious to modify the base system of Sawada et al and modify such with either the acknowledged prior art or Lee, motivation is to use existing disc formats and hence increase the dynamics of the Sawada et al system so as to be backward compatible with existing formats.

2. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 1 above, and further in view of Ikeda et al or Lee et al.

With respect to the limitation of claim 2, see Ikeda et al with respect to the reading of the serial number of the disc, hence the disc id, or alternatively as designated in Lee et al figure 4.

It would have been obvious to modify the base system as stated above in paragraph 1, motivation is to place the id frames at the appropriate place in the leading section of the pma area because id information requires less frames than the address information for all the tracks on the disc.

3. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1 and 32 above, and further in view of Takeuchi.

Claim 5 recites the ability of having the rewrite at an appropriate condition. The examiner interprets this as being when an interrupt/power lost, etc. occurs in a composite disc system having volume identification temporarily lost due to system failure(s), and as further taught by Takeuchi, starting at col. 8 line 1 to col. 9 line 32 is appropriately rewritten.

4. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 1 above, and further in view of Misaizu et al.

Misaizu et al teaches in this environment the ability of having 10 frames/blocks – see col. 5 lines 50 plus.

It would have been obvious to modify the base system of paragraph 1 above with the additional teaching from Misaizu et al, so as to decrease the processing time, i.e., processing in units of 10 frames.

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Allowable Subject Matter

As noted in the previous OA, claims 4, 8, 12, 18-27, 29 and 31 are allowable. Furthermore, claims 33, and 38 and 39 are allowable as well. Nevertheless, as also noted, since claims 4, 8 and 12 are substantially duplicative of each other claims 8 and 12 are objected to under MPEP § 706.03 (k). Appropriate cancellation is required.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M Psitos whose telephone number is (703) 308-1598. The examiner can normally be reached on M-Thursday 8 - 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (703) 305-6137. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aristotelis M Psitos
Primary Examiner
Art Unit 2653

AMP

